

5           REMARKS:

Applicant thanks the Examiner for acknowledgement of the allowable subject matter.

Claims 1-38 have been canceled and new claims 39-44 have been presented to include all the limitations and recommendations of the examiner. No new matter is  
10   added.

Hence the Applicant believes the claims to be in allowable condition.

Yie 6,431,465 fails to disclose, does not teach and shows no interest in making earthen dirt vacuum able. Yie 6,431,465 fails to disclose a vacuum means. Yie is focused  
15   on a way to crack rock.

Simons 5,016,717 fails to disclose, does not teach and shows no interest in the novel technology of using pressurized water to create a high pressure gaseous propellant for propelling a liquid into earthen dirt for the purpose of making it vacuum able.

Prior to the current novel invention, it has not been obvious to anyone to develop an  
20   efficient means for making dirt more vacuum able via using a pressurized liquid for pressurizing a gas and then using the pressurized gas for propelling the liquid into the dirt.

It is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art rejection, the references themselves must suggest that they  
25   be combined. E.g.as was stated in In re Sernaker, 217 U.S.P.Q. 1,6 (C.A.F.C. 1983):

**“Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.**

5       **One skilled in THE art does not apply to combining Yie and Simons. Their  
inventions are not within THE same art. Yie is classification 239/88 and Simons is  
classification 175/66.**

The suggestion to combine the references should not come from applicant. This was  
forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S.P.O. 193,  
10   199(CAFC 1983):

**“It is wrong to use the patent in suit (here the patent application) as a guide  
through the maze of prior art references, combining the right references in the  
right way to achieve the result of the claims in suit (here the claims pending).  
15   Monday morning quarterbacking is quite improper when resolving the  
question of nonobviousness in a court of law (here the PTO).”**

As was further stated in Uniroyal, Inc. v. Rydjub-Wiley Corp., 5 U.S.P.O.2d 1434  
(C.A.F.C. 1988),

20   “(w)here prior-art references require selective combination by the court to render  
obvious a subsequent invention, **there must be some reason for the combination  
other than the hindsight gleaned from the invention itself.....*Something in the  
prior art must suggest the desirability and thus the obviousness of making the  
combination.***” (Emphasis supplied.)  
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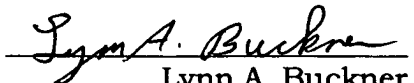
In line with these decisions, recently the Board stated in Ex parte Levengood, 28  
U.S.P.O.2d 1300 (P.T.O.B.A. &I. 1993):

30   “*In order to establish a prima facie case of obviousness, it is necessary for the  
examiner to present evidence, preferably in the form of some teaching, suggestion,  
incentive or inference in the applied prior art, or in the form of generally available  
knowledge, that one having ordinary skill in the art would have been led to combine  
the relevant teachings of the applied references in the proposed manner to arrive at  
the claimed invention....That which is within the capabilities of one skilled in the  
art is not synonymous with obviousness....That one can reconstruct and /or explain  
35   the theoretical mechanism of an invention by means of logic and sound scientific  
reasoning does not afford the basis for and obviousness conclusion unless that logic  
and reasoning also supplies sufficient impetus to have led one of ordinary skill in  
the art to combine the teachings of the references to make the claimed  
invention.....Our reviewing courts have often advised the Patent and Trademark  
40   Office that it can satisfy the burden of establishing a prima facie case of  
obviousness only by showing some objective teaching in either the prior art, or*

5 knowledge generally available to one of ordinary skill in the art, **that ‘would lead’**  
**that individual ‘to combine the relevant teachings of the**  
**references.’.....Accordingly, an examiner cannot establish obviousness by**  
**locating references which describe various aspects of a patent applicant’s**  
10 **invention without also providing evidence of the motivating force which would**  
**impel one skilled in THE art to do what the patent applicant has done.”**

“A claim is anticipated only if each and every element as set forth in the  
claim is found, either expressly or inherently described, in a single prior art  
reference.” Verdegaal Bros. vs. Union Oil Co. of California, 2 U.S.P.Q. 2d1051,  
15 1053 (Fed. Cir. 1987), (emphasis added). See M.P.E.P. 2131.

Respectfully submitted,

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423-413-7823